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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,661	10/23/2003	Fumito Uemura	Q78091	5897
23373	7590	04/22/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			NGUYEN, HANH N	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,661

Applicant(s)

UEMURA ET AL.

Examiner

Nguyen N Hanh

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/962,344.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed on 10/23/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. A copy of "JP 6-81437" was not found. It has been placed in the application file, but the information referred to therein has not been considered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is a single claim which claims both an apparatus (a resin molding die) and the method steps of using the apparatus (a resin filled around each of said magnets for fixedly securing said magnets to said flywheel) is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission work-stand and the method of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph (see MPEP § 2173.05 (p) part II).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 1 is rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine", but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of the invention in the alternative only. *Id.* At 1511.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiga et al. in view of Odazima et al.

Regarding claim 1, Shiga et al. show a combination of a magneto-generator and a resin molding die, the combination comprising: said magneto-generator having: a bowl-shaped flywheel (1 in Fig. 3); a plurality of magnets (2 in Fig. 2) mounted on an inner peripheral surface of said flywheel and a resin (Fig. 2) filled around each of said magnets for securing said magnets to said flywheel; and resin molding die (10 in Fig. 4a and 4b) having: an outer peripheral surface positioned in opposition to an inner peripheral surface of said flywheel and an annular recess (11) to accommodate the

permanent magnets in a circumferential direction (Col. 3, lines 60-65). Shiga et al. fail to show the projections provided in-said outer peripheral surface abutting-against and retaining said plurality of said magnets (2) in a circumferential direction at predetermined positions.

However, Odazima et al. disclose a magneto generator wherein the ring-shape magnet element holder 5 (Fig. 5) having the projections (5a) provided in the outer peripheral surface of the ring abutting against and retaining said plurality of said magnets (4) in a circumferential direction at predetermined positions facing the inner peripheral of the flywheel (1) before dip in an adhesive varnish solution for the purpose of securing the magnet to the inner peripheral of the flywheel (Col. 1, lines 5-10).

Since Shiga et al. and Odazima et al. are in the same field of endeavor, the purpose disclosed by Odazima et al. would have been recognized in the pertinent art of Shiga et al.

It would have been obvious at the time the invention was made to a person having an ordinary skill in the art to modify Shiga et al. by forming protrusion on the outer surface of the die to hold the plurality of permanent magnets in a circumferential direction at predetermined positions as taught by Odazima et al. for the purpose of securing the magnet to the inner peripheral of the flywheel.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh N Nguyen whose telephone number is (571) 272-2031. The examiner can normally be reached on Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberger, can be reached on (571) 272-2044. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

HNN

April 15, 2004

A handwritten signature in black ink, appearing to read "Dangle", written in a cursive style.

**DANGLE  
PRIMARY EXAMINER**